

REMARKS

Claims 1-23 are pending in the present patent application. The Examiner has rejected claims 1-23. Applicant has amended claims 1, 2, 3, 7, 9, 10, 11, 12, 14, 15, 16, 17, 18, 19, and 23 to hasten allowance of the present case. Applicant reserves the right to prosecute the former claims in a continuation or divisional application. Applicant respectfully requests reconsideration of claims 1-23 in view of at least the following amendments and remarks.

I. Rejection of Claims 1-6, and 12-22 Based on 35 U.S.C. § 112

The Examiner has rejected claims 1-6, and 12-22 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states:

Claims 1-6 and 12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the Amendment, filed on 3/12/01, applicant included a clean copy of the claims, but did not include a marked up copy of amended claims. Based on a comparison of the present Amendment, and an Amendment, filed on 10/30/00, it appears that claims 1, 12, and 17 were amended to delete reference to "attachment to an e-mail message". However, each of these claims is labeled as "twice amended", similar to the Amendment, filed on 10/30/00. In addition, applicant's primary argument in the present Amendment is that the combination of Borman and Kelley do not describe "attaching to an e-mail message an attachment associated with a selected portion of a current data resource". Should claims 1, 12, and 17 each include reference to "attachment to an e-mail message"?

The answer to Examiner's question is "yes," claims 1, 12, and 17 should each include reference to "attachment to an e-mail message." Those references were inadvertently deleted in Applicant's amendment and response filed March 12, 2001 for this case.

Specifically, Applicant notes that the Amendments herein to add the phrase "to an e-mail message in response to a user event, said attachment" to claim 1, as well as to add the phrase "and attach said attachment to an e-mail message" to claims 12 and 17 are provided to correct the omissions made inadvertently and without deceptive intent in the Applicant's amendment and response filed March 12, 2001. Therefore, as discussed by Applicant and Examiner during the telephone interview of July 19, 2001, neither those inadvertent omissions nor the current amendments described above to replace them are ground for history estoppel or *Festo* estoppel.

Applicant has amended claim 1 to add the phrase "to an e-mail message in response to a user event, said attachment" and claims 12 and 17 as to add the phrase "and attach said attachment to an e-mail message" to replace those phrases which were inadvertently deleted. Applicant submits that claims 1-6, and 12-22 as amended, comply with 35 USC §112.

II. Rejection of Claims 1-23 Based on 35 U.S.C. § 103

The Examiner has rejected claims 1-23 under 35 USC §103(a) as being unpatentable over Borman et al. (U.S. patent 5,890,172) in view of Kelley (U.S. patent 6,078,921). The Examiner states:

As per claim 1, Borman et al., hereinafter Borman, teach the following subject matter:

a browsing mechanism, with browser interface 400, at Figs. 5A – 5C, and col. 7, lines 52-53, configured to render a current data resource, i.e., a file retrieved by the browser, and to navigate through plural data resources, using the Back 412, Forward, and Home 414 buttons; and

an attachment mechanism, using jumper window 300, at Fig. 3, configured to retrieve an attachment from the browser in response to a user event, i.e., by a selecting a hot-link with a mouse, at col. 6, lines 55 – 60, the attachment associated with the

current data resource, since the "hot-links are extracted from a file initially retrieved by the browser".

Regarding claim 1, Borman describes that in another embodiment, "the user will be able to invoke the product form within their electronic e-mail box simply by double-clicking on attached files" at col. 12, lines 62 – 64. However, Borman does not specifically teach attaching the attachment to an e-mail message. Nor does Borman specifically teach a selection mechanism to select a portion of a current data resource.

On the other hand, Kelley teaches a method for selecting a portion of a current data resource in response to user input, at Fig. 6C, and col. 7, lines 16 – 30, which results in a "single file that can be used to store and view multi-part files" and create a "single attachment of multi-part files in an e-mail system", at col. 7, lines 38 – 41. For example, Kelley teaches that the combined file "can be coupled to a e-mail message" at col. 7, lines 41 – 42.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to attach a portion of a current data resource to an e-mail message as taught by Kelley in the invention of Borman because it allows a user to "convert multi-part files into a single file for use and transfer" at col. 4, lines 19 – 20.

Borman teaches that the attachment comprises a resource locator [claim 2] at col. 7, lines 62 – 63, or source data [claim 3] associated with the current data resource at col. 13, lines 32 – 38.

Kelley teaches selecting an attachment type [claim 4] at Fig. 6C, and col. 7, lines 34 – 35.

Furthermore, Borman teaches that the attachment mechanism comprises a button [claim 5] with refresh/update button 326, at Fig. 3, and col. 7, lines 17 – 19. As to claim 6, Borman teaches navigating to a first data resource, in browser window 406, using a resource locator, with hot-link 580, in a second data resource, in jumper window 300, all at Fig. 6.

Regarding claims 7 – 11, they are similar to claims 1, 4, 2, 3, and 6. Claims 12 – 16 correspond respectively to claims 7 – 11; while claims 17 – 19, 21, and 23 correspond to claims 1 – 3, 6, and 1.

As per claim 20, the first part is similar to claim 4, while the second part is taught by Borman with site window 404, at col. 7, line 32, and at Fig. 5A, which allows a user to select the property value by entering the site location.

As to claim 22, Borman teaches the following:

a stack configured to contain resource locators of navigated data resources, with history creation process 712, at Fig. 7, and col. 9, lines 40 – 42; and

one or more methods configured to browse navigated data by stepping forward or backward within the stack, at col. 9, lines 43 – 56.

Response to Arguments

Applicant's arguments filed 3/12/01 have been fully considered but they are not persuasive.

Applicant's primary argument regarding the combination of Borman and Kelley is that they do not describe "attaching to an e-mail message an attachment associated with a selected portion of a current data resource". The examiner does not agree because Kelley teaches selecting a portion of a data resource, at Fig. 6C, and col. 7, lines 16 – 30, wherein the "data resource" is represented by the source folder, and the "selected portion" is represented by the selected files contained within the source folder.

Applicant respectfully disagrees and submits that claims 1-23, as amended, are allowable for at least the reason that the prior art does not teach, suggest, or describe selecting a portion of a current document from a data resource being browsed and attaching to an e-mail message an attachment associated with that selected current document portion, or the corresponding elements or means.

Independent claims 1, 7, 12, 17, and 23, as amended include:

a selection mechanism configured to select a portion of said current document in response to a user input;

an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an e-mail message in response to a user event, said attachment associated with said portion of said current document.

Applicant submits that none of the cited prior art teaches, suggests, or describes these elements, or the corresponding steps or means. In the Examiner's obviousness rejection of claims 7, 12, 17, and 23, the Examiner relied upon Kelley to address the claimed steps. Specifically, in the second paragraph on page 4 of the Examiner's Office Action, the Examiner states that:

Kelley teaches a method for selecting a portion of a current data resource in response to user input, at Fig. 6C, and col. 7, lines 16-30, which results in a "single file that can be used to store and view multi-part files" and create a "single attachment of multi-part files in an e-mail system", at col. 7, lines 38-41. For example, Kelley teaches that the combined file "can be coupled to a e-mail message" at col. 7, lines 41-42

The cited portion of Kelley describes adding together a number of individual single files to create a "multi-part" file. For example, in column 6, lines 39-43, Kelley describes:

In the present invention, a sender initiates creation of a combined file by selecting or compiling a directory of files to be transmitted to a receiver. These files may be hypertext files or any other type of linked file. These files are then concatenated into a single file referred to as a "result" file.

In fact, the cited portion of Kelley specifies that the files in directory be whole individual files. For instance, in column 7, lines 26-30, Kelley describes:

The add button 605 gives interface 611 of FIG. 6C. This interface displays the contents of the selected source folder. Individual files can be added to the result file by clicking on the Add button of interface 611.

Moreover, in the Examiner's response to Applicant's arguments in the last paragraph on page 5 and first paragraph on page 6 of the Examiner's Office Action, the Examiner states that:

Kelley teaches selecting a portion of a data resource, at Fig. 6C, and col. 7, lines 16 – 30, wherein the "data resource" is represented by the source folder, and the "selected portion" is represented by the selected files contained within the source folder.

Here the Examiner points out that it is entire files from the directory that are selected in Kelly. Thus, in order to accomplish its purpose, Kelley requires that whole individual files be added to the directory from which those whole individual files are concatenated into a single "multi-part" file whose parts are the individual files. However, in Kelley, selecting a portion of a document for attachment to an e-mail is not accomplished.

In contrast to Kelley, Applicant claims the following steps or their corresponding elements, or means:

- a selection mechanism configured to select a portion of said current document in response to a user input;
- an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an e-mail message in response to a user event, said attachment associated with said portion of said current document.

Here Applicant claims selecting a portion of a current document from a data resource being browsed and attaching to an e-mail message an attachment associated with that selected current document portion. For instance, according to Applicant's claims, the user can browse various data resources, such as web pages having graphics icons and URLs, streams of video and/or audio, and text and document files. While browsing, the user can select portions of such resources, such as specific graphics icons and URLs, sections or clips of video and audio, and portions of text and documents from a number of text files and documents. Then the user can attach to an e-mail an attachment associated with the selected portions, such as the selected graphics icons and URLs, sections or clips of video and audio, and portions of text and documents selected from text files and documents. Therefore, the user's selecting of a portion of a current document and attaching to an e-mail message of an attachment associated with those selected portions of the current document of the Applicant's invention is distinct from the chaining together of a number of complete individual single files to create a "multi-part" file which contains the whole of each of those entire files, of Kelley.

Dependent Claims 2-6, 8-11, 13-16, and 18-22

Applicant respectfully submits that claims 2-6, 8-11, 13-16, and 18-22, being dependent upon respective allowable base claims 1, 7, 12, and 17, are also allowable for at least the foregoing reasons stated above.

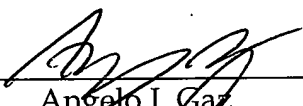
CONCLUSION

For at least the foregoing reasons, Applicant respectfully submits that pending claims 1-23 are patentably distinct from the prior art of record and in condition for allowance. Applicant therefore respectfully requests that pending claims 1-23 be allowed.

Respectfully submitted,

THE HECKER LAW GROUP

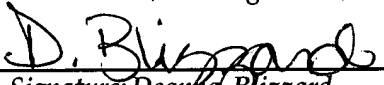
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 8-16-01
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MARKED-UP VERSION SHOWING CHANGES

CLAIMS

What is claimed is:

1. (THREE TIMES AMENDED) An apparatus comprising:
a browsing mechanism configured to render a current data resource in a display region of a graphical user interface, said current data resource comprising at least one current document, said browsing mechanism configured to navigate through a plurality of data resources;
a selection mechanism configured to select a portion of said current [data resource] document in response to a user input;
an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an e-mail message in response to a user event, said attachment associated with said portion of said current [data resource] document.
2. (ONCE AMENDED) The apparatus of claim 1, wherein said attachment comprises a resource locator associated with said current [data resource] document.
3. (ONCE AMENDED) The apparatus of claim 1, wherein said attachment comprises source data associated with said current [data resource] document.
4. (UNCHANGED) The apparatus of claim 1 wherein said attachment mechanism is configured to select an attachment type of said attachment.

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5. (UNCHANGED) The apparatus of claim 1, wherein said attachment mechanism comprises a button on said graphical user interface.
6. (UNCHANGED) The apparatus of claim 1, wherein said browsing mechanism is configured to navigate to a first data resource using a resource locator in a second data resource.
7. (THREE TIMES AMENDED) A method for selecting attachments comprising:
- displaying a graphical user interface having a browsing mechanism configured to render a data resource and having a selecting mechanism configured to select a portion of a desired data resource;
 - browsing through one or more data resources using said browsing mechanism to determine a desired data resource, said desired data resource comprising at least one current document;
 - selecting said portion of said [desired data resource] current document using said selecting mechanism; and
 - retrieving an attachment from said selecting mechanism and attaching said attachment to an e-mail message, said attachment associated with said portion of said [desired data resource] current document.
8. (UNCHANGED) The method of claim 7 further comprising the step of selecting a type of said attachment.

MARKED-UP VERSION SHOWING CHANGES

9. (ONCE AMENDED) The method of claim 7 wherein said step of retrieving said attachment comprises retrieving a resource locator of said [desired data resource] current document.

10. (ONCE AMENDED) The method of claim 7 wherein said step of retrieving said attachment comprises retrieving source data associated with said [desired data resource] current document.

11. (ONCE AMENDED) The method of claim 7, wherein said step of browsing comprises the step of navigating a resource locator in said [one or more] documents.

12. (THREE TIMES AMENDED) A computer program product comprising:

a computer usable medium having computer readable code embodied therein for selecting an attachment, said computer program product comprising:

computer readable code configured to cause a computer to display a graphical user interface having a browsing mechanism configured to render a data resource and having a selecting mechanism configured to select a portion of said data resource;

computer readable code configured to cause a computer to respond to user input to browse through one or more data resources using said browsing mechanism, said data resources comprising at least one current document;

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computer readable code configured to cause a computer to respond to user input to select said portion of said [data resource] current document using said selecting mechanism; and

computer readable code configured to cause a computer to retrieve an attachment from said selecting mechanism and attach said attachment to an e-mail message, said attachment associated with a [desired data resource] current document.

13. (UNCHANGED) The computer program product of claim 12 further comprising computer readable code configured to cause a computer to receive user input to select a type of said attachment.

14. (ONCE AMENDED) The computer program product of claim 12 wherein said computer readable code configured to cause a computer to retrieve said attachment comprises computer readable code configured to cause a computer to retrieve a resource locator of said [desired data resource] current document.

15. (ONCE AMENDED) The computer program product of claim 12 wherein said computer readable code configured to cause a computer to retrieve said attachment comprises computer readable code configured to cause a computer to retrieve source data associated with said [desired data resource] current document.

MARKED-UP VERSION SHOWING CHANGES

16. (Once amended) The computer program product of claim 12, wherein said computer readable code configured to cause a computer to respond to user input to browse comprises computer readable code configured to cause a computer to navigate a resource locator in said [one or more] documents.

17. (THREE TIMES AMENDED) A memory configured to store data for access by a computer system, comprising:

a data structure stored in said memory and associated with a graphical user interface, said data structure comprising:

a browsing component comprising:

one or more methods configured to render a current data resource, said current data resource comprising at least one current document;

one or more navigation methods configured to navigate between a plurality of data resources;

one or more navigation components configured to invoke said one or more navigation methods of said browsing component in response to user input; and

one or more selecting components configured to select a portion of said current [data resource] document in response to a user input; and

an attachment component comprising a method configured to retrieve an attachment from said selecting component and attach said attachment to an e-mail message in response to a user input, said attachment associated with [a desired data resource] said current document.

MARKED-UP VERSION SHOWING CHANGES

18. (ONCE AMENDED) The memory of claim 17, wherein said attachment comprises a resource locator of said [desired data resource] current document.

19. (ONCE AMENDED) The memory of claim 17, wherein said attachment comprises source data associated with said [data resource] current document.

20. (UNCHANGED) The memory of claim 17, wherein said data structure further comprises:
a property which determines a type of said attachment; and
a selection method configured to allow a user to select a value of said property.

21. (UNCHANGED) The memory of claim 17, wherein said one or more navigation methods are configured to navigate a resource locator in a data resource in response to a user input.

22. (UNCHANGED) The memory of claim 17, wherein said browsing component further comprises:
a stack configured to contain resource locators of navigated data resources;
one or more methods configured to browse said navigated data resources by stepping forward and backward within said stack.

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23. (THREE TIMES AMENDED) An apparatus comprising:

a browsing means for rendering a current data resource in a display region of a graphical user interface, said current data resource comprising at least one current document, said browsing means for navigating through a plurality of data resources;

means for selecting a portion of said [plurality of data resources] current document in response to user input; and

means for retrieving an attachment from said selecting means and attaching said attachment to an e-mail message in response to a user event, said attachment associated with said current [data resource] document.